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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/134,799 08/14/98 MIHURA

B

EXAMINER

TM02/0507

BRUCE MIHURA
6302 COLINA LANE
AUSTIN TX 78759

PSITES, A
ART UNIT

PAPER NUMBER

2651
DATE MAILED:

05/07/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/134,799

Applicant(s)

MIHURA, BRUCE

Examiner

Aristotelis M Psitos

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 02 April 2001.
- 2a) ☐ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-61 is/are pending in the application.
- 4a) Of the above claim(s) 2,4-28,31-34 and 36 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3,29,30,35 and 37-61 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claims _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 18) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

✓ A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 4/2/01 has been entered.

Drawings

The drawing informalities noted in Paper No. 2, mailed on 4/13/00 are repeated. Applicant is required to submit a proposed drawing correction in reply to this Office action. However, formal correction of the noted defect can be deferred until the application is allowed by the examiner. ✓

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

1. Claims 45-59 and 61 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 45 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 1 (filing of the application) filed Aug. 14, 1998.

In that paper, applicant has stated that the crux of the invention centered on the fact that the storage system (record medium) was substantially permanently fixed to the chassis, and this statement indicates that the invention is different from what is defined in the claim(s) because such a limitation is now found in dependent claim 60, not in independent claim 45.

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2. Claims 45-53,55-61 are rejected under 35 U.S.C. 112, second paragraph, as failing to set forth the subject matter which applicant(s) regard as their invention. Evidence that claim 45 fail(s) to correspond in scope with that which applicant(s) regard as the invention can be found in Paper No. 10 filed 4/2/01. In that paper, applicant has stated with respect to the "display substantially only status information ...", and this statement indicates that the invention is different from what is defined in the claim(s) because such is not in the independent claim 45, but appears in dependent claim 54. *Repeal*

3. Claims 45-59 and 61 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The independent claim (claim 45) recites the ability to receive and store audio information. Unfortunately no audio input ability is recited. This is found in claim 60. The examiner recommends including such limitation into the independent claim.

Additionally, claim 50 requires an audio input, which is not available, until an audio input ability is recited. The dependent claims fail to clarify the above and fall accordingly.

4. Claims 1,3,29,30,35,37-42, 46-48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Independent claim 1, lines 21-22 recited the coupling of the user interface control system to —ONE OR MORE — of the nonvolatile random-access storage system. Unfortunately, only ONE of these has been claimed; therefore, the alternative ability is not possible.

The dependent claims fail to clarify the above and fall with the parent claim.

With respect to claim 46, because is a duplicate of the above limitations with respect to the ability of coupling to one or more – it also fails. Dependent claims 47 & 48 do not clarify this deficiency and fall with their parent claim.

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5. Claim 58 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claim 58 recites that "a portion" of the chassis is acoustically shielded. Unfortunately, although page 22, lines 10-15 provides for generic acoustically shielding, it is to the entire chassis, no specific portion is mentioned. Hence this claim is considered drawn to new matter.

6. If applicant were to amend independent claim 45 to correct for the above problems with respect to 35 USC 112 paragraphs 1 & 2, then claim 45 would be a duplicate of claim 1. The examiner would fail to discern the patentable distinction between these claims. It is recommended that applicant cancel the second set of claims (new claims 45-57, 60 and 61) and realign the dependency of claims 58 and 59 to claim 1 to reduce the issues.

As far as the claims recite positive limitations the following rejections are made.

Claim Rejections - 35 USC § 102

7. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claim Rejections - 35 USC § 103

8. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

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9. Claims 45-57, 59 and 61 are rejected under 35 U.S.C. 102(a/b) as being anticipated by Kenwood model 1050MD, or Marantz model DR-700 under 102 (a) considerations, or anticipated by MDS-JA3ES minidisc recorder *under 102 (b) considerations*.

With respect to the independent claim 45, the examiner notes that there is no audio input, no permanently fixed to the chassis limitations contained therein. Hence the examiner concludes that this claim is anticipated by the above apparatuses as described in the accompanying documents.

With respect to the dependent claims, the examiner concludes they are either inherently present therein, or obvious thereof.

The ability of having a play list (claim 49), directories (claims 47 & 48), continuously record (claim 50), display of current music information (claims 51, 53, 55), current time display (claim 52), ONLY status information, or information regarding audio info. stored in the storage system (claim 54), the system being substantially only operable for storage and playback of musical pieces (claim 56), the appearance of the display (claim 57), a mute capability in a remote control device (claim 59), an audio input ability (claim 61) are limitations present in these audio playback/record devices. They are descriptive of features found/contained therein.

With respect to the limitations of claim 46, the above system would certainly be coupled to one of the storage medium.

If applicant can convince the examiner that these features are not present in the above base systems, then the examiner would take (takes) Official notice of such features. The above noted features are considered well known to those of ordinary skill in the art and the modification of the above base references with such features would have been obvious to one of ordinary skill in the art, motivation being to increase the marketability of the device by providing for desirable features.

10. Claim 58 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 45 above, and further in view of either Jo or Wyler.

The additional ability of having acoustic shielding in this environment is considered to be known and taught by either Jo or Wyler.

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It would have been obvious to one of ordinary skill in the art to modify the base systems stated above with respect to claim 45 with the additional teaching from either Jo or Wyler. Motivation being to provide for the desired dampening of the noise.

11. Claim 60 is rejected under 35 U.S.C. 103(a) as being unpatentable over the base systems as applied to claim 45 above, and further in view of Schindler et al.

The examiner interprets claim 45 as being drawn to an audio recording & playback device not requiring the substantially fixing of the storage system to the chassis.

This additional feature is found in the Schindler et al system, in which in this environment it discusses the ability of using a disc drive to increase the storage capability – see col. 10, line 59 to col. 13 line 5.

It would have been obvious to one of ordinary skill in the art to modify the base systems relied above with respect to claim 45 with the additional teaching from Schindler et al. Motivation being to provide for a “untouchable record medium”. Having such a record medium would provide for a sealed environment for the record and hence at the very least reduce contamination due to finger prints and smudges when exchanging recording media.

12. Claims 1, 37, 38³⁹_^ and 40 are rejected under 35 U.S.C. 103 (a) as being obvious over either Capps et al, Rossmere et al or Taguchi et al, each further considered with either OFFICIAL NOTICE or Ishii et al and all further considered with DorEl.

Capps et al teaches the claimed invention (**independent claim 1**) including:

a) Chassis for housing electrical components - although not shown, such is inherent in the Capps et al reference - see fig.s 1 & 2 and their description wherein the housing contains at least the input serial port 11, memory 13 and sound editor 14.

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b) At least one audio input & at least one audio output - again, applicant's attention is drawn to fig. 1 and its description where the serial port 11 is the input (audio) and the output is shown as being from element 13 to the speakers 18.

c) nv-ram (non-removable) - memory 13 - computer memory - mag. disc.

d) User interface system - at least keyboard 17 in fig. 1

e) User interface control system - at least the sound editor 14 and its components.

The examiner interprets the operation of the system disclosed in Capps et al as providing for the appropriate control/selection of the audio input - doing the audio editing - and/or selection of the audio output in response to the users control.

Rossmere et al teaches the claimed invention (**independent claim 1**) including:

a) Chassis - see fig. 1 - chassis around either elements 84, 86 or 89

b) At least one audio input & at least one audio output - although not clearly depicted, there is in/out capability for the above mention elements 84,86,89 -

c) nv-ram (non-removable) - elements 199 - audio disks - 410

d) User interface system - audio panel 152 - see fig. 3b and its disclosure

e) User interface control system - at least element 155 & 162

The examiner interprets the operation of the system disclosed in Rossmere et al as providing the appropriate control of the audio input signals for storage onto the audio discs as decided by the user.

Taguchi et al teaches the claimed invention (**independent claim 1**) including:

a) Chassis - inherent - since the electrical components - depicted in fig. 1 do not exist out in the open but are contained.

b) Audio in and out - see fig. 1 and its disclosure where the examine interprets the input from element 12 and the output to element 42.

c) nv-ram (non-removable) see element 40.

d) User interface system - control panel 50

e) User interface control system - at least CPU 30

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The examiner interprets the system of Taguchi et al as providing for appropriate control for storage of audio information onto the HDD of the system as required.

All of the cited documents have a display (see the term display in each of the documents).
The positioning of the display on the front side of the chassis to be either

a) inherently present -normal usage (common sense) dictates that a display is placed where it can be readily seen by a user, i.e., normally on the FRONT SIDE.

Alternatively, if applicant can convince/successful argue that such is not inherently present in the above systems, then the examiner takes Official notice of placing a display on the front side of an electronic unit/chassis for ease of viewing. Motivation is to place the display component in a location readily discernable by the user.

The functional ability of displaying substantially only ... is taught Ishii et al - see figures 6a-d and the associated disclosure thereof.

It would have been obvious to one of ordinary skill in the art to modify the above systems of either Taguchi et al, Rossmere et al, or Capps et al with the additional teaching from Ishii et al, or Official notice & Ishii et al. Motivation is to display only that information which the user is interested in, or alternatively, to reduce cost by having less display elements/complexity. ✓✓

The additional new limitation re the appearance/size of the device is considered to be within the skill of the artisan and well know – as further evidenced by DorEl.

The ability/desirability of reducing the size of the overall system so as to become that of standard audio equipment is considered taught by DorEl – see col. 3 line 65 to col. 4 line 8.

It would have been obvious to one of ordinary skill in the art to modify the base systems cited above with the additional teaching from DorEl. Motivation is to make the system fit within a users home entertainment center as stated by DorEl.

WRT claims 37, ³⁹38 and 40, the examiner points to the disclosure of figure 6 in Ishii et al which meets these limitations.
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13. Claim (s) **3,29 & 30** are rejected under 35 U.S.C. 103(a) as being unpatentable over either the references as relied upon above with respect to claim 1 and each further considered with Yoshida et al.

The REFERENCES relied upon above with respect to claim 1 teach the claimed invention (**independent claim 1**) substantially as claimed as analyzed above.

None of the references (cited above) clearly teach the above listed details of the directory with the common characteristics as found in claim 3. However, **Yoshida et al** teach in an audio system the additional ability of having its nv-ram operable to store a plurality of directories - contents found in the TOC thereof - which as interpreted by the examiner as containing at least song titles, (music names) record disc titles - etc. and these are interpreted as the "common characteristics" found in claim 3. Furthermore, Yoshida et al provides for additional ability of accessing whatever title/record/desired by the user using these TOCs. It is also noted that claims 29 and 30 do not call for any of the 'common characteristics' limitation. Applicant's attention is drawn to col. 4 line 11 to col. 14 line 29. It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify **any of the references** relied upon above with the teachings of **Yoshida et al**. Motivation is to provide for a more versatile recording/duplicating /editing capability by allowing the user to recreate/create his own custom record. The desire to make a copy of an original source of information is well recognized in the audio arts.

14. Claim **35** is rejected under either 35 U.S.C. 102 (b) as being anticipated by or alternatively under 35 U.S.C. 103(a) as being unpatentable over **any of the REFERENCES** relied upon as stated above with respect to claim 1 and each **IN VIEW OF OFFICIAL NOTICE**

The references are relied upon for the reasons stated above.

Claim 35 calls for a first mode of operation - continuous recording - since all of the primary references have a record capability - the examiner interprets such as the first mode to provide for

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continuously store (record) the audio input. The examiner considers this limitation inherently present in the above primary references.

Alternatively, if applicant can convince the examiner that none of the primary reference provide for this "continuously storing" of the audio information , then the examiner considers such a capability as being well know, and takes official notice of such. In the recording arts, the ability to store (continuously) the incoming information - much like time delay recording well known by those with VCRS (video cassette/ tape recorders)- is set under normal recording conditions - i.e., either select a time and day or just operate the "record" function and continuously storing of the incoming signal (video and audio) is performed. Obviously the ability to selective play back a portion of this stored information is also self-evident.

It would have been obvious to one of ordinary skill in the art to take the above well-known capability and modify any of the primary references -motivation being to add greater flexibility in the operating system.

15. Claim 42 is rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claim 1 above, and further in view of the acknowledged prior art display device.

The examiner interprets the limitations of claim 43 as being supported by the acknowledged prior art display device as found on page 15, last line of the specification.

It would have been obvious to one of ordinary skill in the art to further modify the prior art as relied upon wrt claim 1 and further modify them with the acknowledged prior art display - motivation being to take advantage of all ready existing technology and hence save resources in not needing to re-invent the wheel.

16. Claim 41 is rejected under 35 U.S.C. 103(a) as being unpatentable over the prior art as applied to claim 1 above, and further in view of Ishii et al.

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As far as the examiner can ascertain, this limitation is purely a desired result, i.e., if a user is interested in only recording one specific type of information - say audio - limiting the above prior systems to only such an ability is considered:

a) Inherently present in Capps et al and Taguchi et al

b) Obvious over Rossmere et al either from the above limited ability from either Capps et al or Taguchi et al, or as further taught by Ishii et al.

Motivation for recording/limiting a system to only one type of information is considered obvious predicated on routine engineer selection criteria to save resources, i.e., focus in on only one type of signal for processing and hence no need to have additional processing capabilities necessary.

17. Claim 43 is rejected under 35 U.S.C. 103(a) as being unpatentable over the base references as applied to claim 1 above, and further in view of either Wyler or Jo.

The additional ability of having acoustic shielding in this environment is considered to be known and taught by either Jo or Wyler.

It would have been obvious to one of ordinary skill in the art to modify the base systems stated above with respect to claim 1 with the additional teaching from either Jo or Wyler. Motivation is to provide for the desired dampening of the noise.

18. Claim 44 is rejected under 35 U.S.C. 103(a) as being unpatentable over the base references as applied to claim 1 above, and further in view of Official notice.

The availability of a "mute" control is considered to be well known and Official notice is taken thereof. This type of control is normally found in electronic equipment that provides for an audio output and the use thereof to control the audio output and provide for such a condition is considered well within the skill of the artisan.

It would have been obvious to one of ordinary skill in the art to modify the base systems relied upon with respect to the independent claim with the additional teaching with respect to a mute ability. Motivation is to for a more flexible controlled environment.

Response to Arguments

19. Applicant's arguments filed 4/2/01 have been fully considered but they are not persuasive.

Applicant's arguments are drawn to:

a) the newly inserted limitation with respect to the appearance/size – which has been addressed above, and:

b) none of the cited prior art used against claim 1 provides for the display to be operational for substantially only status information of the system and the information found therein.

Although applicant is correct that the display abilities of the base references to Capps, Rosmere, and Taugchi are drawn to display monitors, the claim merely recites that as part of the user interface system a display is **operable** to display ----. This is considered to be true of the above systems.

Additionally, it is noted that the rejection is under 103 and as further stated in the Office action Ishii et al discloses a display system providing for the above limitation as well and motivation for combining its teaching with the above base references was provided. Applicant argues that such a modification of the display functionality of the base systems would not be obvious, due to:

a) mostly –inaccessible computer system desirable

b) no motivation to modify the display systems to resemble that of Ishii et al.

The examiner notes again that the claims merely recite that the display is operable to display such information – and that such an ability would be obvious by using the teaching from Ishii et al and hence make the display of the base systems OPERABLE as claimed. As to the desirability of such, again, users are always willing to change the display found on their pcs – this is human condition as noted by the myriad of “wall papers” (backgrounds) found on individuals desk tops. The examiner considers the desirability to be always be present.

The examiner has treated the newly presented claims as noted above.

Applicant's attention is also drawn to the following documents:

a) Bodo et al - see figures 1& 2 wherein a chassis is depicted having the appropriate

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memory device and control elements - input 44a-d, output through element 112, display -element 24 - although the examiner has not relied upon this reference to reject the claims at hand, applicant is reminded of his duty under 37 CFR 1.111 (c).

b) Lang - see figures 1 and 2 - wherein the chassis - inputs (36), output (46), storage device 13, control elements 14, display - on front side - see fig. 1.

c) Fasciano et al - see figures 1, 4 and 5 - various display capabilities for an audio station.

d) Kulas - figures 3 & 5 - note input/output through bus 108, disk drive 122, control elements - 112 - & chassis. Although the display is through the conventional crt/monitor, smaller lcd displays on front of a chassis have been shown above - see Bodo et al for instance.

e) Haneda - see figures 3, 12, - note in/out display, user controls, system controls and recording medium 105.

f) Osterhout - an audio rec/playback device note especially the recorder chip as stated in col. 11 lines 28 plus. Incoming audio information is recorded and subsequently provided as an output through a user interface system. The examiner acknowledges that there is no display thereon.

g) Smith - col. 4 lines 25+ which disclose the ability of a hard drive to store selected information -

audio. h) *Johnson et al. see Figs 1, 5 & col. 5 line 15 to col 6 line 15.*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aristotelis M Psitos whose telephone number is (703) 308-1598. The examiner can normally be reached on M - Thursday 8 - 4 EST.

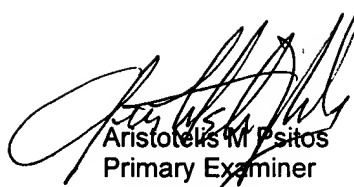
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on (703) 308-4825. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-6606 for regular communications and (703) 308-6606 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

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Aristotelis M. Psitos
Primary Examiner
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